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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,950	07/23/2001	Shripad S. Bhagwat	10624-047-999	3712

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT PAPER NUMBER

1626

DATE MAILED: 04/30/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.



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EXAMINER

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DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-87 ☐ are pending in the application.
Of the above, claim(s) 22-69, 75-84, 86 and 87 ☐ are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-4, 7-9, 13, 21 and 70 ☐ are rejected.
- ☒ Claim(s) 5, 6, 10-12, 14-20, 71-74 and 85 ☐ are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

DETAILED ACTION

Claims 1-87 are pending in the application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, 70-74 and 84, drawn to products, classified in classes 540, 544, 546, and 548.
- II. Claims 22-49, 75-79 and 86, drawn to methods, classified in class 514, various subclasses
- III. Claims 50-69, 80-84 and 87, drawn to methods, classified in class 514, subclasses.

The inventions are distinct, each from the other because of the following reasons: Inventions of Group I and Groups II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially

different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case, the product can be used in a materially different process of using that product.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and the search required for Group I, for example, is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Michael Bruner {Reg. No. 47,458} on April 23, 2002, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-21, 70-74 and 85. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-69, 75-84, 86 and 87 are withdrawn from

further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

In claim 73, delete the additional period at the end of the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7-9, 13, 21 and 70 are rejected under 35 U.S.C. 102(a)

as being anticipated by:

a) Rodgers et al. {U.S. Pat. 5,985,867} – see, for example, Table 1, Examples 35, 40, 54, 55, 142, etc. in columns 43 and 44; column 51, lines 28-67, as well as the claims in the patent;

b) Boehm et al. {Journal of Medicinal Chemistry (July 13, 2000), 43(14), pages 2664-2674} – see compound 5 at the top of page 2669 or CA Registry No. 293758-67-5;

c) Kawakami et al. {Organic Letters, (February 10, 2000), 2(3), pages 413-415} – see page 415, column 2, the compound 5-nitro-3-(4-nitrophenyl)benzopyrazole or CA Registry No. 259876-53-4;

d) Patel et al. {Bioorganic & Medicinal Chemistry Letters (November 15, 1999), 9(22), pages 3217-3220} – see, for example, compound 6a on page 3219; and

e) Carter et al. {GB 2,345,486 – only pages 1-5 and 139 supplied} – see the compound named on page 139, lines 10-11 or CA Registry No. 307328-34-3.

Each of the above cited references disclose products embraced by the instant claims.

Claims 1-4, 7-9, 21 and 70 are rejected under 35 U.S.C. 102(b) as being anticipated by:

a) Bell et al. {U.S. Pat. 3,541,110} – see, for example, Example 1 in column 5; column 4, lines 5-30; and the compounds in column 6, lines 55-75;

b) Vasilevsky et al. {CA 125:114539, 1996} – see, for example, 5-nitro-3-[(4-nitrophenyl)methyl]-1H-indazole (CA Registry No. 178971-64-7);

c) Andronati et al. {CA 122:314528, 1995} – see, for example, 5-chloro-3-phenyl-1H-indazole (CA Registry No. 13097-03-5);

- d) Buck et al. {CA 120:299030, 1994} – see, for example, 3-(6,7-dimethoxy-1-isoquinolinyl)-1H-indazol-5-ol (CA Registry No. 154458-84-1);
- e) Rickinger et al. {CA 116:235509, 1992} – see 5,5'-difluoro-3-nitro-1,3'-bi-1H-indazole (CA Registry No. 141071-17-2);
- f) Grayshan et al. {CA 112:216936, 1990} – see 5-chloro-3-(4-pyridinyl)-1H-indazole (CA Registry No. 126971-86-6);
- g) Fujimura et al. {CA 107:198159, 1987} – see, for example, 3-phenyl-1H-indazole-5-carbonitrile (CA Registry No. 83684-54-2);
- h) Wrzeciono et al. {CA 103:123405, 1985} – see, for example, 5,5'-dichloro-3-nitro-1,3'-bi-1H-indazole (CA Registry No. 98083-49-9);
- i) Jones et al. {CA 100:51503, 1984} – see 5-fluoro-3-phenyl-1H-indazole (CA Registry No. 57614-63-8);
- j) Pfoertner et al. {CA 97:72295, 1982} – see, for example, 5-bromo-3-(2-pyridinyl)-1H-indazole (CA Registry No. 82616-92-0);
- k) Arya et al. {CA 88:37692, 1978} – see 3-(1H-imidazol-1-yl)-5-nitro-1H-indazole monohydrochloride (CA Registry No. 65092-57-1);

- l) Fujimura et al. {CA 84:31053, 1976} – see, for example, 5-bromo-3-phenyl-1H-indazole (CA Registry No. 57639-16-4);
- m) Walser et al. {CA 83:164108, 1975} – see 2-(5-chloro-1H-indazol-3-yl)phenol (CA Registry No. 55076-04-5); and
- n) Horner et al. {CA 70:77962, 1969} – see, for example, 5-methoxy-3-phenyl-1H-indazole (CA Registry No. 13097-05-7).

Each of the above cited references disclose products embraced by the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell et al. {U.S. Pat. 3,541,110} and Rodgers et al. {U.S. Pat. 5,985,867}, each taken alone.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim indazole products. Bell et al. (column 1, lines 25-55; and column 4, lines 5-30) and Rodgers et al. (column 1, lines 17-22; column 4, lines 1-57; column 6, lines 54-58; Table 1, Examples 35, 54, 142, etc. in columns 43-48; and column 51, lines 28-67) each teach indazole products which are either structurally similar to the instant claimed products (see above 102 rejections) or structurally similar to the instant claimed products that are useful in treating, for example, inflammation.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between some of the products of the prior art and the products instantly claimed is that of generic description.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The motivation to make the claimed products derives from the expectation that structurally similar products would possess similar activity (e.g. an anti-inflammatory). One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating, for example, inflammation. Therefore, the instant claimed products would have been suggested to one skilled in the art.

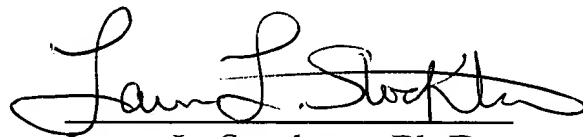
Allowable Subject Matter

Claims 5, 6, 10-12, 14-20, 71-74 and 85 are objected to as being dependent upon a rejected base claim, but would be allowable over the art of record if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235, 308-0196 or 305-3290.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556, 308-4242, 305-1935 or 308-2742.

A handwritten signature in cursive script, reading "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

April 29, 2002